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1 Pursuant to the Court's May 1, 2012 Order (Docket No. 52) and Fed. R.
2 Civ. P. 56, Keating Dental Arts ("Keating") hereby submits this memorandum
3 in support of its motion for summary judgment of (1) No Infringement of
4 Glidewell's Registered Trademark, (2) No Violation Of Section 43(a) of the
5 Lanham Act, and (3) No Unfair Competition Under California Law. Attached
6 as Appendix A is a list of supporting declarations with associated exhibits.

7 **I. PROCEDURAL POSTURE**

8 In February 2012, Keating filed a Motion for Partial Summary Judgment
9 of Non-Infringement. (Docket No. 26.) The Court denied that Motion for, *inter*
10 *alia*, failing to address the Ninth Circuit's eight factor test for determining a
11 likelihood of confusion announced in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d
12 341 (9th Cir. 1979). (*Id.* at 10.) In May 2012, the Court denied Keating's
13 motion for reconsideration and directed Keating to file another motion for
14 summary judgment of noninfringement. (Docket No. 52.) This motion follows.

15 **II. INTRODUCTION**

16 Keating and Glidewell Laboratories ("Glidewell") compete by selling
17 dental restorations, such as crowns and bridges, to dentists across the country.
18 In 2006, Keating began offering a "KDZ Zirconia" crown consisting of a
19 porcelain layer atop a base of zirconia, an extremely strong material used in
20 dental restorations. In May 2011, Keating expanded its zirconia crown product
21 offerings to three, one of which—the physically strongest—was called the
22 "KDZ Bruxer," an all-zirconia crown made for use with "bruxers," people who
23 subconsciously grind their teeth and are prone to breaking conventional crowns.

24 Shortly thereafter, Glidewell sent Keating a cease-and-desist letter for its
25 KDZ Bruxer product based on Glidewell's federal registration in the mark
26 "BRUXZIR," which Glidewell uses (in the form "BruxZir") to market its own
27 all-zirconia crown. Glidewell subsequently filed this lawsuit, bringing claims
28 for (1) infringement of its registered trademark, (2) false designation of origin

1 under the Lanham Act, and (3) unfair competition under California law.

2 Glidewell's claims all fail as a matter of law because (1) Glidewell has no
3 protectable trademark rights in the BRUXZIR mark and, (2) even if Glidewell's
4 mark is assumed to be valid, no reasonable jury could find that a likelihood of
5 confusion exists among dentists or dental labs, the relevant consumer
6 population, regarding the "KDZ Bruxer" mark and the "BruxZir" mark.
7 Glidewell's claims also fail because Keating's use of the generic term "Bruxer"
8 within its mark is protected by the fair use doctrine.

9 Glidewell has no trademark rights in BRUXZIR because it is a phonetic
10 equivalent to "bruxer," the intended users of the product. BRUXZIR is also an
11 improper trademark because it identifies the nature and intended use for the
12 product, a crown for bruxers made of zirconia, rather than the source of the
13 product. BRUXZIR answer the question "what" rather than "who," and thus is
14 an invalid mark. Indeed, dentists have come to consider the terms "BruxZir"
15 and "bruxzir" as generic names for all-zirconia crowns.

16 Even if the mark is assumed valid, analysis of the *Sleekcraft* factors
17 shows that no reasonable jury could find a likelihood of confusion. Any
18 protection provided by BRUXZIR is very narrow due to the widespread use of
19 "Brux" and "Zir" by others in the dental industry. The KDZ Bruxer and
20 BruxZir marks as used in commerce are dissimilar when considered in their
21 entirety. Dentists are highly educated professionals responsible for the health of
22 their patients; they are discerning customers and not easily confused. Keating
23 chose the KDZ Bruxer mark in good faith after conferring with counsel.
24 Despite using the marks in direct competition nationwide for a year and a half,
25 Glidewell has no examples of actual confusion between the marks.

26 Glidewell's Lanham Act claim and unfair competition claim are based on
27 the same facts as its infringement claim, and all three claims fall together.
28 Keating respectfully requests that the Court grant this motion in its entirety.

III. STATEMENT OF UNCONTROVERTED FACTS

A. Dentists and Dental Restorations (“Crowns”)

Crowns and bridges are dental restorations used by dentists to treat patients with damaged or missing teeth. (SOF ¶ 1.)¹ Dentists order crowns from “dental laboratories” that manufacture the crowns based on specifications provided by the dentist. (SOF ¶ 2.) Crowns and other dental restorations are regulated medical products, and dentists order them from dental laboratories by submitting a prescription form signed by the dentist. (SOF ¶ 3.) Finished crowns are not staple goods; they are personalized to the patient with custom-shaping and coloring to fit the needs of a particular tooth for a particular patient. (SOF ¶ 4.)

Dentists are highly educated and trained professionals in the business of patient care. They are responsible for, among other things: (1) assessing whether a patient needs a crown; (2) assessing the type of crown that is best for the patient; (3) creating specifications for the crown personalized to the patient; (4) placing an order with a dental laboratory to have the personalized crown made; (5) ensuring the crown received from the laboratory is correct and high quality; and (6) affixing crowns in the mouths of their patients. (SOF ¶ 5.) Dentists strive to provide excellent patient care, and in this regard they are careful in choosing the dental laboratories with whom they work. (SOF ¶ 6.)

B. Dental Laboratories

There are over 2,000 dental laboratories in the U.S. servicing the needs of dentists. (SOF ¶ 7.) Plaintiff Glidewell, founded in 1970, is by far the largest dental laboratory in the U.S. In 2002, Shaun Keating founded Defendant Keating Dental Arts. (SOF ¶ 8.) Prior to founding his company, Mr. Keating worked for 18 years at Glidewell. (SOF ¶ 9.)

¹ Cites to the record are to the enumerated statements in Keating’s Statement of Undisputed Facts (“SOF ¶ ____.”).

For decades dental labs primarily manufactured crowns made entirely or partially of porcelain, a material that gives a tooth-like appearance. (SOF ¶ 10.) Dental labs have also developed layered combinations of materials, to create stronger crowns that look tooth-like. (SOF ¶ 11.) An example of a layered crown developed years ago is a porcelain-fused-to-metal (“PFM”) crown, which includes a top porcelain layer—visible in the mouth for aesthetics—atop a lower hidden metal layer for strength. (SOF ¶ 12.)

C. Bruxing Patients and the Development of Zirconia Crowns

When it comes to dental restorations, a particularly challenging group of patients for dentists are “bruxers,” patients who subconsciously grind their teeth. (SOF ¶ 13.) Bruxers are notorious for breaking traditional porcelain crowns due to the excessive forces they place on their teeth. (SOF ¶ 14.) Bruxers who have broken porcelain crowns have often had the broken crowns replaced by gold crowns, which are strong and nearly unbreakable. (SOF ¶ 15.) Despite their excellent functional qualities, gold crowns are typically not popular with patients because they do not look like natural teeth. (SOF ¶ 16.)

Zirconia is an extremely strong material that dental labs began using as a substitute for the invisible metal lower layer in PFM crowns. (SOF ¶ 17.) Although Zirconia is white, it does not have the appropriate reflective properties to appear tooth-like, so it is not nearly as aesthetic as porcelain. (SOF ¶ 18.)

1. Keating’s “KDZ Zirconia” Crown (2006)

In 2006, Keating began selling a layered crown with a porcelain top layer and a zirconia base, which it variously called “KDZ,” “KDZ Zirconia,” or “KDZ CAD/CAM Zirconia.” (SOF ¶ 19.) That year (three years before Glidewell came out with its later all-zirconia crown under the “BruxZir” name), Keating Dental Arts gained national recognition as “Best Crown and Bridge Laboratory” from Dental Town, a dental industry community. (SOF ¶ 20.) Below is an excerpt from a Keating brochure from that time.



(SOF ¶ 21.)

Mr. Keating chose to call his new zirconia product “KDZ” as a reference to “Keating Dental Zirconia.” (SOF ¶ 22.) Keating has been selling its layered KDZ crown continuously from 2006 to the present. (SOF ¶ 23.) This layered KDZ crown has been, and remains, Keating’s most popular crown made with zirconia. (SOF ¶ 24.)

2. Glidewell’s “BruxZir” Crown (2009)

In June 2009, Glidewell began offering for sale an all-zirconia crown² under the name “BruxZir.” (SOF ¶ 25.) Below is an excerpt from a Glidewell marketing document.



(SOF ¶ 26.)

Glidewell’s mark for the new crown was a composite of “Brux,” with a capital B, and “Zir,” with a capital Z. The “Zir” has an italicized font, and the

² All-zirconia crowns are also referred to in the dental industry as “full contour zirconia crowns” and “monolithic zirconia crowns.”

1 “Z” partially obscures the “x” giving the impression that the “Zir” letters are in
 2 front of the word “Brux.” (SOF ¶ 27.) Glidewell’s advertising consistently uses
 3 this stylized version of its mark. (*Id.*)

4 Glidewell markets its BruxZir all-zirconia crowns at industry tradeshow, s,
 5 on its internet website, in dental magazines, in brochures mailed to dentists, and
 6 through e-mail blasts sent to dentists. (SOF ¶ 28.)

7 **3. Keating’s KDZ Bruxer Crown and the KDZ Family (2011)**

8 In 2010, Keating began selling a prototype all-zirconia crown as a
 9 substitute for a gold crown in response to requests from its dentist customers.
 10 (SOF ¶ 29.) Dentists began asking for all-zirconia crowns at least part because
 11 the cost of gold had been increasing significantly in recent years. (SOF ¶ 30.)
 12 Glidewell and Keating each sent letters to their respective dentist/customers to
 13 promote all-zirconia crowns as a cheaper replacement for gold. (SOF ¶ 31.)

14 In 2010 and early 2011, Keating did not advertise an all-zirconia crown,
 15 though it sold such crowns to its existing customers who requested them. (SOF
 16 ¶ 32.) Based on the perceived demand for all-zirconia crowns of its dentists,
 17 Keating decided to formally add an all-zirconia crown to its product offerings.
 18 (SOF ¶ 33.)

19 For his new all-zirconia crown, Mr. Keating decided to keep using the
 20 “KDZ” prefix that he had been using continuously since 2006 with his layered
 21 ceramic/zirconia product. (SOF ¶ 34.) To avoid confusion with his new all-
 22 zirconia offering, Mr. Keating decided to rebrand his existing layered “KDZ
 23 Zirconia” crown as the “KDZ Ultra” crown. (SOF ¶ 35.) Keating further added
 24 another new product made with zirconia to its offerings, which Mr. Keating
 25 named the “KDZ Max.” (SOF ¶ 36.)

26 Because the new all-zirconia crown was specifically designed to replace
 27 gold crowns for bruxer patients, Mr. Keating wanted to call the new crown the
 28 “KDZ Bruxer.” (SOF ¶ 37.) On this point, Mr. Keating explained: “We’ve had

our dentists for years always saying, ‘What can I use for my grinding patients, my bruxism patients?’ And gold is through the roof right now. And every day I’m getting calls, ‘What can I do for my bruxer patients? I can’t afford the gold.’ (SOF ¶ 38.)

Mr. Keating sought the advice of counsel to ensure his use of the name would not cause problems. (SOF ¶ 39.) A trademark search was performed by counsel and, after receiving the advice of his counsel, Mr. Keating proceeded to name the new crown the “KDZ Bruxer.” (SOF ¶ 40.)

On March 31, 2011 Keating sent a letter to all of its dentist/customers referencing the increase in the cost of gold and offering a KDZ “family”:

- KDZ Bruxer (“Solid Zirconia for bruxer & grinder patients”);
- KDZ Ultra (a rebranding of the existing KDZ Zirconia product); and
- KDZ Max (a ceramic pressed onto a zirconia base).

(SOF ¶ 41.)

In May 2011, Keating began marketing its new KDZ family using the following stylized marks, which it has been using continuously since:



(SOF ¶ 42.)

The most prominent part of Keating’s mark for its new crown is the prefix “KDZ.” Following is a second word in a smaller font, sometimes in all caps and sometimes lower case with a capital first letter. (SOF ¶ 43.) Keating presents its KDZ Bruxer product as originating from Keating Dental Arts, with no affiliation to Glidewell or any other dental laboratory. The advertisement that Glidewell attached as Exhibit B to the Complaint is typical: “Introducing the all-new KDZ Bruxer. The best full-contour zirconia solution available. *Exclusively from Keating Dental Arts.*” (SOF ¶ 44 (emphasis added).)

1 Keating markets its KDZ Bruxer all-zirconia crowns at industry
 2 tradeshow, on its internet website, in dental magazines, and in brochures
 3 mailed to dentists. (SOF ¶ 45.) Dentists interpret the “KDZ” in Keating’s
 4 marks as a reference to “Keating Dental Zirconia.” (SOF ¶ 46.)

5 **D. Glidewell’s BRUXZIR Mark Is Weak At Best**

6 **1. BruxZir Is Generic Or At Least Highly Descriptive**

7 Glidewell named its all-zirconia crown “BruxZir” because it is a zirconia
 8 crown for bruxers. (SOF ¶ 47.) Since 2009, Glidewell has marketed its all-
 9 zirconia crown at dentists and dental labs for use with bruxer patients. (SOF
 10 ¶ 48.) The name BruxZir is pronounced identically as “bruxer,” the term for a
 11 person with bruxism. (SOF ¶ 49.)

12 **2. The Wide Use of “Brux” and “Zir” In The Dental Industry**

13 In addition to Glidewell and Keating, many other companies have been
 14 using “Brux” to refer to dental products for use with bruxers and “Z” or “Zir” to
 15 refer to dental products associated with zirconia. Examples include: Arthtek
 16 Bruxing Splint; GPS BruxArt; Brux XXX; BruxCure; BruxChecker; Brux-eze;
 17 BruxCare; Bruxguard; Dr. Brux; ZerisBRUX; ZirCAD (zirconia blocks);
 18 ZirPress (for ceramic ingots); ZirLiner (zirconia bonding material); Zir-Cut
 19 (zirconia polisher); ZirBlock (dental products); Zirprime (pre-sintered zirconia);
 20 Zir-Cut (burs for cutting Zirconia); Zir-Cut Diamond FG (specialty burs);
 21 Zir.Care (multipurpose stone); ZiReal (Zr dental posts); and ZirColor (coloring
 22 for zirconia). (SOF ¶ 50.)

23 **3. All-Zirconia Crowns Offered By Other Dental Laboratories**

24 In addition to Glidewell and Keating, many other dental laboratories have
 25 been offering all-zirconia crowns under a variety of names, including names
 26 with “Brux,” “Zir,” or variations thereon. Examples include: Barth Dental Lab
 27 (“Z-Brux”); Burbank Dental (“Zir-Max”); California Dental Arts (“ZirFit”);
 28 Continental Dental (“Full Zirconia for Bruxing Patients”); Cosmetic Dentistry

of SA (“Bruxer Crown”); Dani Dental (“Full Zirconia (Bruxer)”); Diadem Precision Technology (“Diazir”); Distinctive Dental (“Zir-Tech”); Drake Dental (“Zir-Cast”); Expertec (“Full-Z”); GPS Dental Lab (“GPS BruxArt”); Kastle Mills (“ZirCrown”); Mascola Esthetics (“Xtreme Bruxer”); Pittman Dental (“ZirCAM”); Somer Dental Labs (“Full Contour Zir”); Summers Dental Lab (“BruxThetix”); Sun Dental Labs (“Suntech Full Zirconia”); Technics Dental Lab (“Tech/ZIR FC”); Trachsel Dental (“All Zirconia Bruxer”); York Dental Lab (“Bruxer”); and Zahn Dental (“Zirlux”). (SOF ¶ 51.)

4. Glidewell’s “Authorized” Labs Sell “BruxZir” Crowns, Most of Which Do Not Identify Glidewell As An Affiliated Entity

Glidewell makes zirconia “blanks” (the raw material from which zirconia crowns may be made) that it sells to about 180 “authorized” dental laboratories for use by those laboratories in making their own all-zirconia crowns. (SOF ¶ 52.) The “authorized” laboratories make and sell crowns using the BruxZir name, just like Glidewell does. (SOF ¶ 53.) Most of the “authorized” laboratories have web sites promoting their “BruxZir” crowns, often with the same language used in Glidewell’s marketing materials. (SOF ¶ 54.) The vast majority of these laboratories do not identify Glidewell as an affiliated entity. (SOF ¶ 55.) Instead, they typically promote the BruxZir crown as their own crown coming from their own dental laboratory. (*Id.*) Glidewell does not monitor the use of the BruxZir mark by its authorized labs, and it does not require those labs to identify Glidewell as an affiliated entity. (SOF ¶ 56.)

5. Dentists Use The Term “BruxZir” Generically

Up through May 2012, Keating had fulfilled over 5,000 prescription forms by supplying its dentist customers with the KDZ Bruxer product. (SOF ¶ 57.) Over that span, dentists (or their assistants) wrote the word “BruxZir,” “bruxzir,” or variations thereof, on about 75 of the prescription forms requesting Keating’s all-zirconia crown. (SOF ¶ 58.) The number of prescription forms

1 received with these spellings constitutes about 1.5% of the total number of
2 prescription forms received by Keating for its all-zirconia crown. (SOF ¶ 59.)

3 When receiving prescription forms with such misspellings, Keating
4 implemented a policy of calling the dentist to confirm that the dentist wanted
5 Keating's all-zirconia crown, and not the crown from another laboratory. (SOF
6 ¶ 60.) In each instance, the dentist confirmed that they wanted Keating's KDZ
7 Bruxer all-zirconia crown. (SOF ¶ 61.) Keating is submitting declarations from
8 thirteen dentists (identified in the list below) stating that they wrote "BruxZir,"
9 "bruxzir," or variations thereof on their prescription forms as a generic reference
10 to an all-zirconia crown, not because they wanted a crown from Glidewell or
11 were otherwise confused that Glidewell and Keating were affiliated (SOF ¶ 62.):

12 Belton Decl. ¶¶ 9-11; Ex. A; Brady Decl. ¶¶ 9-11; Ex. A;
13 Campbell Decl. ¶¶ 10-12; Ex. A; Colleran Decl. ¶¶ 10-12; Ex. A;
14 Jacquinet Decl. ¶¶ 9-10; Ex. A; Murphy Decl. ¶¶ 9-11; Ex. A;
15 Myers Decl. ¶¶ 9-10; Ex. B; Nussear Decl. ¶¶ 9-11; Ex. A;
16 Richardson Decl. ¶¶ 10-12; Ex. A; Scott Decl. ¶¶ 9-11; Ex. A;
17 Stephens Decl. ¶¶ 10-12; Ex. A; Sweet Decl. ¶¶ 8-10; Ex. A;
18 Tobin Decl. ¶¶ 9-11; Ex. A.

19 Keating is not the only dental laboratory that receives prescription forms
20 from dentists with "BruxZir," "bruxzir," or variations thereon written out as a
21 generic reference to an all-zirconia crown. Showcase Dental Laboratory, a
22 dental lab unaffiliated with Glidewell or Keating, has also received prescription
23 forms from dentists that generically describe an all-zirconia crown as a
24 "BruxZir," "bruxzir," or variation thereon. (SOF ¶ 63.)

25 Glidewell itself uses the term BruxZir generically. (SOF ¶ 64.)

26 ///

27 ///

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E. Glidewell Has Produced No Evidence Of Actual Confusion As To Source Of Goods Or Affiliation Between Glidewell And Keating

Keating served Glidewell with an interrogatory asking Glidewell to identify any examples of actual confusion on the part of third parties regarding a relationship between Keating and Glidewell or Keating's KDZ Bruxer and Glidewell's BruxZir. (SOF ¶ 65.) Glidewell's interrogatory response alleged details for two such instances:

- In April 2012, a Glidewell employee named Nicole Fallon offered a \$20 coupon to Dr. Jade Le's dental office in Florida to try a BruxZir restoration. An employee in Dr. Le's office asked if she could apply the coupon to a previous purchase the office had made of Keating's KDZ Bruxer. (SOF ¶ 66.)
- In May 2011, Dr. Thomas Nussear's dental office placed an order with Keating for a KDZ Bruxer crown and wrote "BruxZir" on the prescription form. (*Id.*)

Keating served Glidewell with a follow up interrogatory asking Glidewell to identify all facts relating to the alleged instance of confusion involving Dr. Jade Le's dental office. (SOF ¶ 67.) In response, Glidewell further explained that Ms. Fallon made a telephone call to Dr. Le's office and offered a discount on BruxZir crowns. (*Id.*)

Glidewell employees, and dental professionals generally, pronounce BruxZir and Bruxer identically. (SOF ¶ 68.) The only confusion apparent from the record associated with Ms. Fallon's phone call resulted from Ms. Fallon's failure to unambiguously identify the product associated with her coupon offer.

Likewise, Glidewell's identification of Dr. Nussear's prescription form is not evidence of actual confusion. Keating is submitting a declaration from Dr. Nussear in which he explains that he wrote "BruxZir" on his prescription form as a generic reference to an all-zirconia crown. In the declaration, Dr. Nussear

1 explains that he did not intend to order a crown from Glidewell, and he was not
2 confused as to any affiliation between Keating and Glidewell. (SOF ¶ 69-70.)

3 **F. Glidewell’s Attempts To Prevent Others From Using “Bruxer” In**
4 **Connection With All-Zirconia Crowns**

5 On January 19, 2010, Glidewell received a federal registration in its
6 trademark “BRUXZIR.” (SOF ¶ 71.) Since that time, Glidewell has relied upon
7 that registration as grounds for threatening trademark infringement suits against
8 any other dental laboratory using “Brux” or “Bruxer” in a mark for an all-
9 zirconia crown. (SOF ¶ 72.) Specifically, Glidewell sent cease-and-desist letters
10 to at least the following dental labs: Assured Dental Lab (“Z-Brux”); Authentic
11 Dental Lab (“Brux”); China Dental Outsourcing (“Bruxer All Zirconia”); Fusion
12 Dental Lab (“Full Solid Bruxer Zirconia”); Old Dominion Milling Corp.
13 (“Bruxzer”); Pittman Dental (“Bruxer All-Zirconia Crown”); R-dent Dental
14 Laboratory (“R-Brux”); and Showcase Dental Lab (“Zir-Bruxer”). (SOF ¶ 73.)
15 In each instance, the dental laboratory chose to change its name rather than face
16 the risk of a lawsuit in Federal court versus Glidewell. (SOF ¶ 74.)

17 **IV. THIS COURT SHOULD GRANT SUMMARY JUDGMENT OF NO**
18 **INFRINGEMENT OF GLIDEWELL’S REGISTERED TRADEMARK**

19 To prevail on its claim for infringement of its registered mark, Glidewell
20 must show (1) ownership of a protected mark; and (2) that Keating is using a
21 colorable imitation of the protected mark in connection with the sale, offering
22 for sale, distribution, or advertising of any goods or services such that Keating’s
23 use is likely to cause confusion among customers of the goods or services.
24 *Applied Info. Scis. Corp. v. eBay, Inc.*, 511 F.3d 966, 969 (9th Cir. 2007); 15
25 U.S.C. § 1114(1)(a).

26 Here, Glidewell’s trademark infringement claim fails both because
27 Glidewell cannot show that its registered mark BRUXZIR is a protected mark,
28 and further because—if Glidewell’s mark is assumed to be valid—Glidewell

cannot show that Keating's use of its own mark, "KDZ Bruxer," is likely to cause confusion among customers with the BRUXZIR mark.

A. Glidewell Does Not Have A Protectable Trademark in BRUXZIR

The trademark holder "bears the ultimate burden of proof in a trademark infringement action," including the burden to show that it has a valid mark. *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005). Because Glidewell has a federally-registered mark, it preliminarily meets its burden because a federally-registered mark is presumed to be protected. *See* 15 U.S.C. § 1057(b) ("A certificate of registration of a mark . . . shall be prima facie evidence of the validity of the registered mark"); *see also Yellow Cab*, 419 F.3d at 928. However, Keating may overcome this presumption by showing by "a preponderance of the evidence" that Glidewell's mark is not protected. *Yellow Cab*, 419 F.3d at 928.

Glidewell should not have received a federal registration in the mark "BRUXZIR" for use with zirconia crowns for bruxers, as the name identifies the product, not the producer. *Yellow Cab*, 419 F.3d at 929. Nor does combining two descriptive terms in and of itself make a mark registrable. *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979), citing *William R. Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526, 528, 44 S. Ct. 615 (1924). The registration is further improper because BruxZir is pronounced the same as bruxer. *See, e.g., Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 79 (7th Cir. 1977) ("Using the phonetic equivalent of a common descriptive word, *i.e.*, misspelling it, is of no avail."). Had the Trademark Examiner learned these important facts from Glidewell or from his or her own research, Glidewell's application for registration would have been rejected.

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B. Even If Glidewell Is Assumed To Have A Protectable Trademark, No Reasonable Jury Could Find A Likelihood Of Confusion

“[T]he burden of proving likelihood of confusion rests with the plaintiff.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 122, 125 S. Ct. 542, 160 L. Ed. 2d 440 (2004). If Glidewell’s BRUXZIR mark is assumed valid, its infringement claim still fails as a matter of law because no reasonable jury could find a likelihood of confusion.

The Ninth Circuit directs district courts to consider the following eight “*Sleekcraft* factors” when assessing the likelihood of confusion between marks: “[1] strength of the [plaintiff’s] mark; [2] proximity of the goods; [3] similarity of the marks; [4] evidence of actual confusion; [5] marketing channels used; [6] type of goods and the degree of care likely to be exercised by the purchaser; [7] defendant’s intent in selecting the mark; and [8] likelihood of expansion of the product lines.” *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011); *see also* *AMF, Inc.*, 599 F.2d 341 (first identifying the factors). However, “the list is not exhaustive,” and “[o]ther variables may come into play depending on the particular facts presented.” *Id.*; *see also* MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, 4TH EDITION, § 24:39. The Court need not “rigidly weigh[]” these factors, nor need it consider all of them. *Dreamwerks Production Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998).

As discussed below, consideration of these factors reveals that no reasonable jury could find a likelihood of confusion in this case.

1. Strength of Glidewell’s Mark

“Trademarks are classified along a spectrum of increasing distinctiveness: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful. Generic and descriptive marks are deemed weak; arbitrary marks are considered strong. However, even ‘strong’ marks will be deemed ‘weak’ if they exist in a ‘crowded

1 field’ of similar marks.” *Instant Media, Inc. v. Microsoft Corp.*, 2007 WL
 2 2318948 at *12 (N.D.Cal. Aug. 13, 2007) (internal quotations omitted). Here,
 3 Glidewell’s mark is extremely weak, to the extent it has any strength at all.

4 Many companies in the dental industry have used “Brux” to refer to
 5 products for use with bruxers and “Z” or “Zir” to refer to products associated
 6 with zirconia, including zirconia crowns. This greatly narrows the scope of any
 7 trademark rights that could exist in the mark BRUXZIR for dental crowns. *See*
 8 *Network Automation, Inc. v. Hewlett-Packard Co.*, 2009 U.S. Dist. LEXIS
 9 125835, *24 (C.D. Cal. Sept. 14, 2009) (plaintiff’s “Network Automation” mark
 10 is generic, or at least extremely weak). *One Indus., LLC v. Jim O’Neal Distrib.,*
 11 *Inc.*, 578 F.3d 1154, 1164 (9th Cir. 2009) (“In a crowded field of similar marks,
 12 each member of the crowd is relatively weak in its ability to prevent use by
 13 others in the crowd.”) (citation omitted); *Glow Indus. v. Lopez*, 252 F. Supp. 2d
 14 962, 990 (C.D. Cal. 2002) (noting the weakness of Glow, Inc.’s mark, which
 15 competes in a crowded field of beauty products using the word “glow” in some
 16 manner as a trademark.)

17 Any scope is further narrowed because Glidewell’s own promotional
 18 videos use the term generically, and because Glidewell allows about 180
 19 competing dental laboratories to sell crowns under the “BruxZir” name without
 20 identifying an affiliation to Glidewell. These practices of Glidewell have
 21 contributed to the genericization of the mark, and dentists widely view
 22 “BruxZir” and “bruxzir” as a generic reference to an all-zirconia crown.

23 Trademark holders often provide evidence of the strength of their marks
 24 by providing survey results of the relevant purchasing public. Here, Glidewell
 25 has presented no such evidence.

26 For the reasons above, this factor weights in favor of a finding of no
 27 likelihood of confusion.

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1 **2. Proximity of Relatedness of Goods**

2 The proximity or relatedness of goods is relevant to determine whether
3 the products “are likely to be connected in the mind of a prospective purchaser.”
4 *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149, 159 (9th Cir.
5 1963). Here, there is no genuine issue of material fact that the products offered
6 for sale by Glidewell under the mark BRUXZIR and by Keating under the mark
7 “KDZ Bruxer” are identical: all-zirconia dental restorations.

8 **3. Similarity of the Marks**

9 “The similarity of the marks will always be an important factor. Where
10 the two marks are entirely dissimilar, there is no likelihood of confusion.”
11 *Brookfield Commc’n, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1054 (9th
12 Cir. 1999). In determining whether marks are similar, courts consider their
13 sight, sound and meaning. *Id.*; see also *Dreamwerks Production Group, Inc. v.*
14 *SKG Studio*, 142 F.3d 1127, 1131 (9th Cir. 1998). “In analyzing this factor, ‘the
15 marks must be considered in their entirety and as they appear in the
16 marketplace.’” *Brookfield Commc’n*, 174 F.3d at 1054 (citations omitted).
17 According to the “anti-dissection” rule, courts may not dissect marks to examine
18 and compare their component parts. MCCARTHY ON TRADEMARKS AND UNFAIR
19 COMPETITION, 4TH EDITION, § 23:41. “[A] court does not consider the similarity
20 of the marks in the abstract, but rather in light of the way the marks are
21 encountered in the marketplace and the circumstances surrounding the
22 purchase.” *Reno Air Racing v. McCord*, 452 F.3d 1126, 1137 (9th Cir. Nev.
23 2006) (citation and internal quotation marks omitted).

24 **Sight**: Keating’s mark, as used in commerce, includes two separate
25 words: “KDZ Bruxer” or “KDZ BRUXER.” In contrast, Glidewell’s mark is
26 presented in commerce as a single word comprising a mixture of capital and
27 small letters and two different fonts: *BruxZir*. See *Echo Drain v. Newsted*, 307
28 F. Supp. 2d 1116, 1126 (C.D. Cal. 2003) (fact that “Echo Drain” is two words

and “Echobrain” is one word helps support finding that marks look different).

Furthermore, in Glidewell’s mark the “Zir” portion cuts off the edge of the “x” giving the appearance that the “Zir” letters appear forward of the word “Brux.”

BruxZir®

Keating’s mark uses block letters side-by-side, often presented as part of a design that includes the name within an oval:



These additional elements help distinguish the parties’ marks as used in commerce. *See Self-Insurance Inst. of America, Inc. v. Software & Information Indus. Ass’n*, 208 F. Supp. 2d 1058, 1071 (C.D. Cal. 2000) (parties’ “SIIA” marks look dissimilar because they include additional elements that are visually distinct, such as an eagle whose wing surrounds part of plaintiff’s mark).

Sound: The second part of Keating’s mark is pronounced identically with Glidewell’s mark in its entirety. The first part of Keating’s mark, “KDZ,” has no similarly sounding counterpart in Glidewell’s mark.

Meaning: The purchasing public—dentists—interpret Glidewell’s mark and the *second part* of Keating’s mark as a reference to the product itself: an all-zirconia dental restoration strong enough for bruxers. Dentists interpret the first part of Keating’s mark, “KDZ,” to mean “Keating Dental Zirconia,” thus identifying the source of the goods: Keating Dental Arts. *See Brockmeyer v. Hearst Corp.*, 248 F. Supp. 2d 281, 296 (S.D.N.Y. 2003) (the meaning of defendant’s “O” is a reference to Oprah Winfrey, while plaintiff’s mark “<<O>>” does not reference a particular personality).

The only commonality between the marks is that they include the well-known dental term “Brux” and the letter “Z.” The appearance of “Z” and

1 “Brux” are both fully explainable wholly aside from issues of identifying
2 source, because both identify characteristics shared by the parties’ products:
3 they are all-zirconia crowns for *bruxers*.

4 When the commonality between composite marks is a term, or letters,
5 that are generic or highly descriptive, courts find the likelihood of confusion
6 reduced. *California Security Alarms v. Escobar’s Security Plus Alarm Systems*,
7 1996 U.S. Dist. LEXIS 14913 (N.D. Cal. 1996) (finding the parties’ marks
8 dissimilar where the commonality, “Security,” describes the parties’ services);
9 *Alchemy II, Inc. v. Yes! Entertainment Corp.*, 844 F. Supp. 560, 569 (C.D. Cal.
10 1994) (finding the marks “Teddy Ruxpin” and “TV Teddy” dissimilar where the
11 commonality, “Teddy,” describes the parties’ products: plush, talking teddy
12 bears); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531 F.3d 1, 25 (1st
13 Cir. 2008) (finding the marks “Boston Duck Tours” and “Super Duck Tours”
14 dissimilar where the commonality, “Duck Tours” describes the parties’
15 services); *Am. Cyanamid Corp. v. Connaught Labs., Inc.*, 800 F.2d 306, 309 (2d
16 Cir. 1986) (finding the marks HibVAX and HIB-IMUNE dissimilar where the
17 commonality, “Hib,” describes the parties’ Haemophilus influenza type b
18 vaccine); *Water Pik, Inc. v. Med-Systems, Inc.*, 848 F. Supp. 2d 1262, 1272
19 (D.Col. 2012) (finding the marks SinuCleanse and SinuSense dissimilar where
20 the commonality, “sinu,” is ubiquitous in the sinus irrigation market);
21 *Smithkline Beckman Corp. v. Proctor & Gamble Co.*, 591 F. Supp. 1229, 1238
22 (N.D.N.Y. 1984) (finding the marks ECOTRIN and ENCAPRIN dissimilar
23 where the commonality, “RIN,” is derivative of the generic term “aspirin”). *See*
24 *also* MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, 4TH EDITION,
25 § 23:49 (when the common element of two trademarks is a generic term, the
26 likelihood of confusion is reduced, as the public has come to expect that element
27 on different products).

28 This factor weighs in favor of a finding of no likelihood of confusion.

1 **4. Actual Confusion**

2 A “lack of evidence about actual confusion after an ample opportunity for
3 confusion can be a powerful indication that the junior trademark does not cause
4 a meaningful likelihood of confusion.” *Cohn v. Petsmart, Inc.*, 281 F.3d 837,
5 843 (9th Cir. 2002). Glidewell began using the mark BRUXZIR in commerce
6 in June 2009. Keating began using the mark “KDZ Bruxer” in commerce about
7 two years later, in May 2011. In this lawsuit Glidewell has identified with
8 particularity two incidents that it characterizes as confusion between the marks.
9 The first of those incidents, involving Keating’s customer Dr. Nussear, was not
10 an example of confusion between the marks. Dr. Nussear has submitted a
11 declaration to correct Glidewell’s misunderstanding regarding the writing of
12 “BruxZir” that he placed on a Keating prescription form.

13 Glidewell is likely to argue that the other prescription forms received by
14 Keating from dentists who wrote “BruxZir,” “bruxzir,” or variations thereof on
15 the Keating Rx forms are also evidence of confusion between the marks. Yet
16 the record shows that those dentists, like Dr. Nussear, wrote “BruxZir” as a
17 generic reference to an all-zirconia crown, not as a request for Glidewell’s all-
18 zirconia crown. Dentists are highly educated professionals who manage
19 challenging professional practices. When a dentist sends a prescription form to
20 Keating requesting an all-zirconia crown, that is precisely what the dentist
21 wants: Keating’s all-zirconia crown. As corroboration to Dr. Nussear’s
22 explanation, eleven additional dentists who wrote “BruxZir,” or variations
23 thereof, on Keating prescription forms have submitted declarations to explain
24 what they wrote, none of whom were confused between the parties’ marks.

25 Regarding the second incident, Glidewell has failed to demonstrate that
26 Ms. Fallon’s communications with the dental office of Dr. Jade Le are evidence
27 of actual confusion regarding the parties’ marks, as opposed to evidence of
28 confusion over the nature of the coupon offer being offered by Ms. Fallon.

1 The fact that Glidewell can point to a modest number of incidents of
 2 confusion in the abstract is inadequate. Relevant confusion is that which affects
 3 purchasing decisions, not confusion generally. *See Echo Drain v. Newsted*, 307
 4 F. Supp. 2d 1116, 1126–27 (C.D. Cal. 2003). Nor does a showing of some
 5 confusion automatically create a triable issue of fact. *See, e.g., Universal*
 6 *Money Centers v. AT & T*, 22 F.3d 1527, 1535 (10th Cir. Kan. 1994); *Universal*
 7 *City Studios, Inc. v. Nintendo Co.*, 746 F.2d 112, 118 (2d Cir. 1984).

8 Finally, Glidewell chose not to provide survey evidence of confusion.
 9 For a company like Glidewell with enormous resources, the absence of survey
 10 evidence itself may be used to infer that the results of the survey would be
 11 unfavorable. *See Playboy Enters. v. Netscape Communs. Corp.*, 55 F. Supp. 2d
 12 1070, 1084 (C.D. Cal. 1999); *Cairns v. Franklin Mint Co.*, 24 F. Supp. 2d 1013,
 13 1041–42 (C.D. Cal.1998) (“[A] plaintiff’s failure to conduct a consumer survey,
 14 assuming it has the financial resources to do so may lead to an inference that the
 15 results of such a survey would be unfavorable.”)

16 **5. Marketing Channels**

17 “Convergent marketing channels increase the likelihood of confusion.”
 18 *M2 Software, Inc. v. Madacy Entm’t*, 421 F.3d 1073, 1083 (9th Cir. 2005)
 19 (quoting *Nutri/System, Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 606 (9th Cir.
 20 1987)). Keating and Glidewell each market their products through Internet
 21 websites, magazine advertisements, mailings to dentists, and trade shows. Here,
 22 there is no genuine issue of material fact that the marketing channels used by
 23 Glidewell and Keating overlap.

24 **6. Types of Goods and Degree of Consumer Care**

25 “It is generally assumed that consumers with expertise or who are buying
 26 expensive products or services exercise a greater degree of care when doing so
 27 and are thus less easily confused.” *Edge Wireless, LLC v. U.S. Cellular Corp.*,
 28 312 F. Supp. 2d 1325, 1333 (D. Or. 2003) (citing *Brookfield Comm’s*, 174 F.3d

1 at 1060). The relevant consumers in this case are dentists who are highly
2 educated and specially trained professionals. The products in this case are
3 dental restorations, regulated medical products that impact the well-being of
4 patients if not designed, manufactured, or affixed properly. Dentists necessarily
5 put great care into the treatment of their patients, and they correspondingly put
6 great care into the selection of a dental laboratory to manufacture dental
7 restorations for their patients. *See Accuride Int'l, Inc. v. Accuride Corp.*, 871
8 F.2d 1531, 1537 (9th Cir. 1989) (holding factor weighed heavily against a
9 finding of likelihood of confusion where purchasers were highly specialized
10 professionals expected to exercise a high degree of care). Thus, this factor
11 weighs in favor of a finding of no likelihood of confusion.

12 7. **Keating's Intent**

13 “When an alleged infringer knowingly adopts a mark similar to another’s,
14 courts will presume an intent to deceive the public.” *Official Airline Guides v.*
15 *Goss*, 6 F.3d 1385, 1395 (9th Cir. 1993). Here, the undisputed evidence shows
16 that Mr. Keating did not have bad intent when he chose the KDZ Bruxer name.
17 First, Mr. Keating chose to use the prefix “KDZ” to designate a zirconia crown
18 from Keating Dental Arts, a nomenclature he had begun in 2006, years before
19 Glidewell began using the name “BruxZir.” Second, Mr. Keating chose the
20 KDZ Bruxer name as one of a family of new “KDZ” product names (with
21 “KDZ Ultra” and “KDZ Max”) that Keating Dental Arts was releasing at the
22 same time. Third, Mr. Keating added the term “Bruxer” to his new all-zirconia
23 crown because he saw bruxers as the target patient for the new crown, based on
24 the requests he received from his dentist customers. Finally, Mr. Keating
25 checked with intellectual property counsel to clear the mark KDZ Bruxer before
26 he decided to go public with the name. Only after getting the green light from
27 counsel did Mr. Keating use the new mark in Keating’s advertising. Thus, this
28 factor weighs in favor of a finding of no likelihood of confusion.

1 **8. Likelihood of Expansion**

2 “Inasmuch as a trademark owner is afforded greater protection against
3 competing goods, a ‘strong possibility’ that either party may expand his
4 business to compete with the other will weigh in favor of finding that the
5 present use is infringing.” *Sleekcraft*, 599 F.2d at 354. Here, the subject
6 products already compete in the same market and are advertised in overlapping
7 marketing channels. Thus, this factor is not relevant.

8 **9. Summary of *Sleekcraft* Factors**

9 To prevail on the ultimate question toward which the *Sleekcraft* analysis
10 is directed—the likelihood of confusion of consumers—Glidewell must show
11 sufficient evidence to permit a rational trier of fact to find that confusion is
12 “probable,” not merely “possible.” *Murray v. Cable NBC*, 86 F.3d 858, 861
13 (9th Cir. 1996). As shown above, Glidewell cannot make such a showing.
14 Keating’s use of the KDZ Bruxer mark has not been “likely to confuse an
15 appreciable number of people as to the source of the product.” *Entrepreneur*
16 *Media, Inc. v. Smith*, 279 F.3d 1135, 1151 (9th Cir. 2002). The only *Sleekcraft*
17 factors that weigh in favor of Glidewell are that the products are identical and
18 marketed in overlapping marketing channels. Yet, because this direct
19 competition has been ongoing for nearly a year and a half with no incidents of
20 actual confusion reinforces that no reasonable jury could find a likelihood of
21 confusion between the BruxZir mark and the KDZ Bruxer mark, considered in
22 their entirety as used in commerce.

23 **C. Keating’s Use Of “Bruxer” In the Mark “KDZ Bruxer” Is Protected**
24 **By The Classic Fair Use Defense**

25 Under the “classic fair use” doctrine, a party is not liable for trademark
26 infringement where it “use[s] a descriptive term in good faith in its primary,
27 descriptive sense other than as a trademark.” *Cairns v. Franklin Mint Co.*, 292
28 F.3d 1139, 1150-51 (9th Cir. 2002). To establish this defense, Keating must

1 prove that its use of “Bruxer” is: (1) not a use “as a trademark or service mark”;
 2 (2) done “fairly and in good faith”; and (3) “[o]nly to describe its goods or
 3 services.” *Cairns*, 292 F.3d at 1150-51.

4 Moreover, “[t]he fair use defense only comes into play once the party
 5 alleging infringement has shown by a preponderance of the evidence that
 6 confusion is likely.” *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*,
 7 408 F.3d 596, 608–09 (9th Cir.2005) (citing *KP Permanent Make-Up*, 543 U.S.
 8 at 118 (“burden of proving likelihood of confusion rests with the plaintiff, and
 9 the fair use defendant has no freestanding need to show confusion unlikely”).

10 Here, as discussed at length above, there is no likelihood of confusion that
 11 results from Keating’s use of the product name “KDZ Bruxer.” However, even
 12 if it is assumed that Glidewell can demonstrate by a preponderance of the
 13 evidence that confusion is likely (which it cannot), Glidewell’s trademark
 14 infringement claim and its related Lanham Act and California unfair
 15 competition claims all fail because Keating’s use of the term “Bruxer” is
 16 protected by the classic fair use defense.

17 First, Keating is not using the term “Bruxer” in its mark as an indication
 18 of source. Indeed, Keating disclaimed the term “Bruxer” in its pending
 19 trademark application for the KDZ Bruxer mark. Rather, Keating uses the term
 20 “Bruxer” to *describe the goods* to which the KDZ Bruxer mark is applied: an
 21 all-zirconia dental restoration strong enough for bruxer patients.

22 As discussed above, Mr. Keating made his decision to use the term
 23 “Bruxer” in good faith in mid-2011 after conferring with counsel. Finally, as
 24 discussed at length above, application of the *Sleekcraft* factors demonstrates that
 25 there is no likelihood of confusion from Keating’s use of KDZ Bruxer.
 26 Accordingly, the classic fair use defense applies, and Glidewell’s trademark
 27 infringement claim fails as a matter of law.

28 ///

1 **V. THIS COURT SHOULD GRANT SUMMARY JUDGMENT OF NO**
 2 **VIOLATION OF SECTION 43(A) OF THE LANHAM ACT**

3 Glidewell’s claim of false designation of origin (Second Cause of Action)
 4 is based on the same allegations as its claim of infringement of its registered
 5 trademark (First Cause of Action):

- 6 • “Defendant Keating’s use of the *infringing trademark* induces
 7 purchasers and others to believe, contrary to the fact, that the products
 8 sold by Defendant Keating are rendered, sponsored or otherwise
 9 approved by, or connected with Plaintiff Glidewell.” (Complaint
 10 (Docket No. 1) at ¶ 22 (emphasis added).)
- 11 • “Defendant Keating’s unauthorized use of the infringing trademark in
 12 connection with the advertising, sale and provision of Defendant
 13 Keating’s dental products constitutes use of a false designation of
 14 origin and a false description with the meaning of Section 43(a) of the
 15 Trademark Act of 1946, 15 U.S.C. §1125(a).” (*Id.* at ¶ 23.)

16 Accordingly, in this case the analysis for Glidewell’s claim of false
 17 designation of origin under Section 43(a) of the Lanham Act (15 U.S.C. § 1125)
 18 is the same as the analysis for infringement of a registered trademark under 15
 19 U.S.C. § 1114. *See Brookfield Comms.*, 174 F.3d at 1046-47 & n. 8 (applying
 20 same analysis to claims under Sections 1114 and 1125).

21 **VI. THIS COURT SHOULD GRANT SUMMARY JUDGMENT OF NO**
 22 **UNFAIR COMPETITION UNDER CALIFORNIA LAW**

23 Glidewell’s claim of unfair competition (Third Cause of Action) is based
 24 on the same allegations as its trademark infringement claim:

- 25 • “Defendant Keating’s activities, as described above [in the First and
 26 Second Causes of Action], constitute unfair competition in violation of
 27 California Business & Professions Code § 17200, et seq. As alleged
 28 above, Defendant Keating *has infringed* and intends to *continue*

